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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,031	10/09/2001	Dale F. McIntyre	83194F-P	5074

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,031

Applicant(s)

MCINTYRE ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,32,33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Request for Continued Examination

1. The request filed on June 16, 2003 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/973,031 is acceptable and a CPA has been established. An action on the CPA follows.

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2. Claim 1 has been amended for further examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-6, 12, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fountain.

Fountain discloses an image product assembly comprising a dual sided album leaf having a first ply (14) and a second ply (15) having an outer surface and an inner surface; the plies are secured together so as to form a pocket (20); wherein the outer surface of the first or second ply has at least one image or images (photo seen in Fig. 1); an insert (10) having a size and configuration so that it can be placed within the pocket and also wherein the insert has information ("BIOGRAPHY") relating to the image; wherein the information is located in a position such that it can be readily identified (the information can be identified when tab (12) is pulled upon by the end user) with respect to the associated image; and wherein the insert is

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provided with a retaining member or restraining tabs (11) designed to be stopped by a retaining section (17).

However, Fountain does not disclose: wherein the outer surface of the first or second ply has a plurality of images formed; wherein the information also includes a copy of the associated image at a reduced copy having reduced visual characteristics; wherein the outer surfaces of the either the first ply or second ply has a plurality of images, and wherein the information on the insert is located such that it can be readily identified with respect to which of the plurality of images it is associated.

In regards to **Claim 1**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many images as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claim 3, 32 and 33**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any type of image on the plies' outer surface and on the restrained insert, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the insert and ply substrate may render the more convenient by providing an individual with a specific type of form does not alter the functional

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relationship. Mere support by the substrate (insert and plies) for the printed matter (image and information) is not the kind of functional relationship necessary for patentability. Thus, there is no novel an unobvious functional relationship between the printed matter and the substrate which is required for patentability. Furthermore in regards to **Claim 3**, it would have been an obvious matter of design choice to construct an image in any desired size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

In regards to **Claim 4**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the image on any desirable ply outer surface(s), since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claim 12**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the image assembly as one sheet folded to form two layers, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

4. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fountain in view of Young (6,061,938).

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Fountain discloses an image product assembly comprising all the elements as set forth in Claim 1, and as set forth above. However, Fountain does not disclose: wherein the insert is folded such that when it is placed in the pocket, it is retained.

Young discloses in Fig. 4, an assembly comprising a slidable foldable insert (32), wherein when it is placed in a pocket (as seen in Fig. 1-3) it is retained.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fountain's to include a foldable insert as taught by Young for the purpose of holding and securing additional indicia.

5. Claim 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fountain in view of Hawley (3,848,348).

Fountain discloses an image product assembly comprising all the elements as set forth in Claim 1, and as set forth above. However, Fountain does not disclose: wherein the first and second ply layers are adhesively secured along three sides of four sides, wherein the adhesive is placed on two surfaces of a spacer, which is then placed between the ply layers.

Hawley discloses an image assembly comprising a spacer (6) having adhesive on both of its surfaces and placed between ply layers (4 and 8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fountain's image assembly to include an adhesively placed

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spacer as taught by Hawley for the purpose of connecting the plies and forming a pocket for the insert.

Response to Arguments

6. Applicant's arguments filed on June 16, 2003 have been fully considered but they are not persuasive.

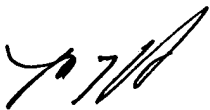
In response to applicant's arguments that the present invention sets forth that there is a first and second ply layer wherein each has a plurality of images, the examiner submits that claim 1 does not disclose this limitation. Claims 1 discloses in 5, "said outer surface of said first and/or second ply layer having at least one image formed..". Therefore, either the first or second ply layer can comprises an image(s). This is disclosed in the Fountain reference. In response to applicant's arguments that the references do not disclose a plurality of images formed, and that the information is not readily identified with respect to the images. The examiner submits that in regards to the plurality of images, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many images as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. In regards to the insert having information that is readily identified with respect to the images, the examiner submits that Fountain does indeed disclose information that is located in a

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position that such that it can be readily identified with respect to the image. This is shown in Fig. 1 of the drawings, wherein the information is in a position (after the tab has been pulled upon to release the insert) that is readily identified with respect to the image.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

June 26, 2003



A. L. WELLINGTON
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